

REMARKS

Claims 1-3, 5, 7 and 10-15 are now pending in the application. Claims 11-12 and 14 have been currently amended. Pending claims 11-15 stand rejected under 35 U.S.C. § 102(e). The forgoing amendments and following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

I. Rejection Of Pending Claims 11-15 Under 35 U.S.C. § 102 (e)

Claims 11-15 stand as rejected under 35 U.S.C. § 102 (e) as being anticipated over Gotoh et al., U.S. Patent No. 6,730,155, issued May 4, 2004 ("Gotoh"), as applied to currently amended claim 11. Applicants respectfully traverse this rejection.

A. Relevant Law

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

B. Summary of Cited References

Gotoh teaches an aqueous ink composition comprising a coloring agent comprising at least one pigment, a dispersant for dispersing the coloring agent, a wetting agent, a penetrating agent and water. The ink composition having a surface tension of 20 mN/m or more and less than 35 mN/m. See Abstract. However, nothing in Gotoh either teaches or suggests an ink for ink jet recording consisting essentially of a pigment, water, polyethylene glycol and diglycerol.

C. Argument

The Examiner asserts that Gotoh discloses an aqueous ink composition comprising at least one pigment, a dispersant, a wetting agent a penetrating agent and water which may be used for an ink jet recording. The Examiner also argues that Gotoh discloses that the weight ratio of the polyethylene glycol with respect to the pigment appears to be not more than 3 as shown by examples 4 and 22. Although the Examiner concedes that Gotoh remains silent as to whether the water contained in the ink is evaporated and the solid matter is redissolved in the ink which is not solidified, the Examiner asserts that similar compositions with similar amounts would inherently have these same properties. Thus, the Examiner concludes that the composition taught in Gotoh anticipates the present invention. Applicants respectfully disagree with the Examiner's analysis.

Currently amended claim 11 defines an ink for ink-jet recording consisting essentially of a pigment, water, polyethylene glycol and diglycerol.

Gotoh teaches an aqueous ink composition comprising a coloring agent comprising at least one pigment, a dispersant for dispersing the coloring agent, a wetting agent, a penetrating agent and water. See Abstract. Gotoh does not teach an ink for ink jet recording consisting essentially of a pigment, water, polyethylene glycol, and diglycerol. Gotoh does not even mention diglycerol. In addition, Applicants agree with the Examiner that Gotoh does not specifically teach the ink for ink-jet recording where the ink is solidified into a solid matter when the water contained in the ink is evaporated, and the solid matter is redissolved in the ink which is not solidified. Accordingly, Gotoh fails to teach or disclose each and every limitation of independent claim 11. To the extent that the Examiner finds each and every limitation of claim 11 in Gotoh, it nonetheless is insufficient for it does not contain an enabling disclosure. Thus, the invention defined in amended claim 11 and the dependent claims thereof is not anticipated by Gotoh. For these reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 (e) are respectfully requested.

II. Rejection Under 35 U.S.C. § 102 (e)

Claims 11-15 stand as rejected under 35 U.S.C. § 102 (e) as being anticipated over Satoh et al., U.S. Patent No. 6,793,724, issued September 21, 2004 ("Satoh"), as applied to currently amended claim 11. Applicants respectfully traverse this rejection.

A. Relevant Law

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

B. Summary of Cited References

Satoh teaches an ink for ink-jet recording, comprising a pigment; an anionic surfactant; and a cationic surfactant. See Abstract. Satoh also teaches that the content of the cationic surfactant is smaller than the content of the anionic surfactant in the ink for ink-jet recording. However, nothing in Satoh either teaches or suggests an ink for ink jet recording consisting essentially of a pigment, water, polyethylene glycol and diglycerol.

C. Argument

The Examiner asserts that Satoh discloses an ink composition comprising a pigment and a surfactant. The Examiner also states that Satoh discloses that a permeating agent may be present in the ink composition. The Examiner argues that Satoh teaches that the ink composition may also contain a moistening agent wherein polyethylene glycol is a preferred solvent. Then the Examiner points to Example 2 for showing ink compositions similar to the present invention where the weight ratio of the polyethylene glycol with respect to the

pigment appears to be not more than 3. Further, the Examiner argues that the polyethylene glycol, which may be a molecular weight of 200 to 400, are liquid at ordinary temperature and ordinary pressure. Although the Examiner concedes that Satoh remains silent as to whether the water contained in the ink is evaporated and the solid matter is redissolved in the ink which is not solidified, the Examiner asserts that similar compositions with similar amounts would inherently have these properties. Thus, the Examiner concludes that the composition taught in Satoh anticipates the present invention. Applicants respectfully disagree with the Examiner's analysis.

As stated above, currently amended claim 11 claims defines an ink for ink-jet recording consisting essentially of a pigment, water, polyethylene glycol and diglycerol.

Unlike the present invention, Satoh does not disclose that diglycerol is used in the ink composition for ink-jet recording. Also, Applicants agree with the Examiner that Satoh does not specifically teach the ink for ink-jet recording where the ink is solidified into a solid matter when the water contained in the ink is evaporated, and the solid matter is redissolved in the ink which is not solidified. Accordingly, Satoh fails to teach or disclose each and every limitation of independent claim 11. To the extent that the Examiner finds each and every limitation of claim 11 in Satoh, it nonetheless is insufficient for it does not contain an enabling disclosure. Therefore, Satoh does not anticipate claim 11. Claims 12-15, by virtue of their dependency from claim 11, are similarly considered by Applicants to patentably define themselves and are novel over Satoh. For these reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 (e) are respectfully requested.

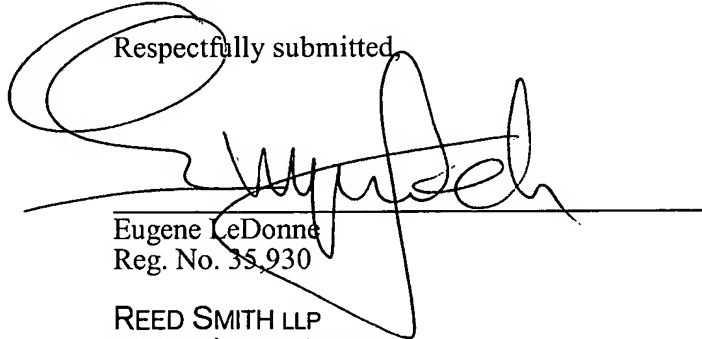
III. Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's notation on page 4 of the Office Action that claims 1-3, 5, 7 and 10 are allowed.

IV. Conclusion

For the reasons presented above, claims 1-3, 5, 7 and 10-15, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,



Eugene LeDonne
Reg. No. 35,930

REED SMITH LLP
599 Lexington Avenue
New York, NY 10022
(P) 212-521-5402

Attorney for Applicant